

Remarks/Arguments

This response is to the Office Action dated March 9, 2006.

Claims 1, 2, 5-8 and 10 remain in this application.

Claims 1, 2, 5-7 and 10 have been rejected under 35 USC 102(b) in view of GB 2,302,042 A.

Applicants disagree.

The present invention requires the a thermoplastic elastomer as a gasket formed through the thickness of a filter (claim 1) or a screen (claim 2) and having a thickness greater than respective filter or screen through which it is formed.

The reference fails to teach each and every element of the present invention and as such is not an anticipatory reference. In particular, the reference fails to teach the use of a thermoplastic elastomer that is formed through the thickness of the filter or screen and which has a thickness greater than that of the filter or screen through which it is formed.

The reference clearly teaches that the EVA copolymer is placed "between" the layers not through the layers. See GB 2302042, Abstract, line 3, "positioned between the elements"; Page 1 third paragraph "between the filtration medium and support material"; Page 2, line 9, "positioned between the structural elements" and line 35 "between"; Page 4, lines 27-28 "positioned between the filtration media"; Page 5, lines 1-2 "between the filtration media"; Page 6, lines 16-17 "between the support materials"; line 34 "positioned between the membrane"; Page 7 lines 12-13 " positioned between the membrane and the support material"; and claim 1 line 5 "positioned between said structural elements".

The only statement it has to embedding the copolymer layer is at pages Page 6, line 27 and page 7, lines 17-19 in which an additional diffusion layer between the membrane and support layer

may preferably be "partially embedded in the copolymer **positioned between the membrane and the support material.**" (Applicants emphasis).

Contrary to the statement made in the Office Action, it is clear that the reference fails to teach the gasket material extending through any layer, never mind the membrane or screen as is required by the present claims. At best, it states that at best a middle layer can be partially embedded into the copolymer layer that is between the filter and support layers.

Additionally it is clear that the copolymer layer of the reference does not extend beyond the thickness of the layer through which it must extend as is required by the present claims. Contrary to the unsupported assertion in the Office action, the copolymer layer of the reference does not "penetrate several layers of the membranes and screens". At best, it is partially embedded into a diffusion layer that is between the filter and support layers as is clearly stated in the reference. It is clear that it does not have a thickness extending beyond the layer in which it is formed through as is required by the present claims.

As the standard for anticipation is one of strict identity and "the reference must teach every aspect of the claimed invention either explicitly or inherently." (MPEP section 706.02IV, lines 6 and 7) and the cited reference has failed to teach the claimed elements of the present claims, this reference is not and cannot be an anticipatory reference. As such, the rejection based on 35 USC 102(b) is respectfully requested to be withdrawn as it fails to provide a reference which contains all of the claimed elements of the present claims and therefore no basis for rejection under 35 USC 102 has been properly made.

Claims 1, 2, 5-8 and 10 have been rejected under 35 USC 103(a) over Rogemont (US 4,701,234) in view of the GB reference. Applicants disagree.

The office action states that Rogemont fails to teach or suggest a thermoplastic elastomer but that the GB reference does and that it would have been obvious to substitute the EVA copolymer of the GB reference for the raw, cured in place silicone of Rogemont. Applicants disagree.

The office action's position is based upon the disclosure in the GB reference that its EVA copolymer has low extractables and layers can be sealed together into one body using the material. The Office Action fails to consider the clear teaching that the EVA layer of the GB reference is used between layers of the device and it uses its good adhesive properties to bond the layers together.

What teaching is present to motivate one skilled in the art to use the EVA material of the GB reference in the process of Rogemont? The skilled artisan would have to ignore the teachings of the GB disclosure regarding the placement of the EVA between the layers and using its excellent adhesion properties to hold the layers together, focus only on the EVA material itself, and somehow arrive at the conclusion that it could be compressed under pressure as taught by Rogemont to fill the mesh of Rogemont. EVA is a thermoplastic (Applicants contest whether it is a thermoplastic elastomer as claimed in the present invention and the Office Action fails to supply any evidence to that effect) and it would be solid until melted. One of ordinary skill in the art would not have been suggested or motivated to use the GB EVA in the Rogemont process as suggested in the present office action.

As stated by the Federal Circuit in *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1986), "One cannot use hindsight reconstruction to pick and choose from isolated disclosures in the prior art to deprecate the claimed invention."

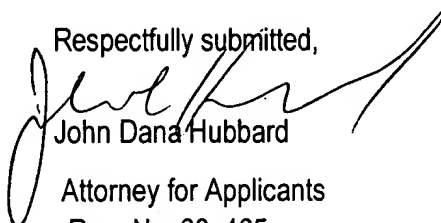
Of similar import is *In re Wesslau*, 147 U.S.P.Q. 391, 393 (CCPA 1965):

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." (Emphasis added).

The combination of the two references would not have led to the claimed invention. At best the cited combination would have led to the use of the polymerizable thermoset silicone of Rogemont in the device of the GB reference or the use of the EVA layer between the various layers, relying on the "excellent adhesion" of the EVA to bond the layers together. However that is not the presently claimed invention. As such it is believed the prima facie case of obviousness has been rebutted and the rejection should be withdrawn.

Reconsideration and allowance are respectfully requested in view of the foregoing amendment and remarks.

Respectfully submitted,



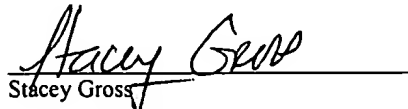
John Dana Hubbard

Attorney for Applicants
Reg. No. 30, 465

September 8, 2006
Millipore Corporation
290 Concord Road
Billerica, Massachusetts 01821
Tel.: (978) 715-1265
Fax: (978) 715-1382

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 8, 2006.


Stacey Gross